

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-5 and 7-22 remain in the application. Claims 5 and 7-11 are subject to examination and claims 1-4 and 12-22 have been withdrawn from examination. Claim 5 has been previously amended. Claim 6 has been previously canceled.

In item 5 on page 3 of the above-identified Office Action, claims 5 and 7-11 have been rejected as being unpatentable over Montgomery et al. (U.S. 5,947,028) (hereinafter "Montgomery") in view of Leanna et al. (U.S. 4,116,594) (hereinafter "Leanna") under 35 U.S.C. § 103(a).

It is noted that while the rejection of the claims is based on Montgomery in view of Leanna, the Examiner has referred to Welch Jr. et al. (U.S. Patent 3,670,646) in at least two instances in her statements regarding the rejection. Since Welch Jr. is not mentioned in the rejection in the first sentence of item 5 on page 3, applicants assume that the reference to Welch Jr. is a typographical error and that the Examiner intended to refer to Leanna instead of Welch, Jr..

Accordingly, applicants will treat the rejection as based on Montgomery in view of Leanna.

As will be explained below, it is believed that the claims were patentable over the cited art in their previous form and, therefore, the claims have not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 5 calls for, *inter alia*, an imaging assembly, having a printing plate, and an imaging machine for setting an image on the printing plate, the printing plate formed of a magnetically attractable material, the imaging machine including a magnetic cylinder magnetically holding the printing plate firmly during the setting of an image thereon, the magnetic cylinder having at least one magnet for attracting the printing plate magnetically and being selected from the group consisting of permanent magnets and electromagnets, the magnetic cylinder having a register system aligning the printing plate, and the printing plate having substantially U-shaped register cut-outs cooperating with the register system. (emphasis added)

Montgomery discloses printing, printing plates, and drums therefor as disclosed in col. 1, lines 5 et seq. In particular, Montgomery discloses apparatus for holding metal printing plates on a rotating drum by the use of a vacuum. Holding the plates in place on the drum is facilitated by bending at least one edge of the plate to approximately match the drum curvature. Montgomery does not disclose or suggest substantially U-shaped cut-outs for aligning the printing plate accurately in position relative to the magnetic cylinder, before it is firmly clamped in place, according to the present claimed invention. Montgomery is silent on and does not disclose the use of magnets. The Examiner acknowledges that **Montgomery is silent** with respect to primary features of claim 1, namely, "the particular details of the magnetic drum and whether the magnetic material in the cylinder includes one of a permanent magnet and electromagnet" and "whether the drum includes a register system for aligning the printing plate with U-shaped register cut-outs."

Contrary to Montgomery, Leanna discloses embossing, embossing plates, and embossing rollers therefor. Leanna discloses an embossing apparatus for applying a continuous pattern to webs of material such as paper and a method for producing an embossing surface.

In item 5 of the above-identified Office Action, the Examiner uses the terms "printing/embossing plate" and "magnetic printing/embossing drum", which is based on an erroneous assumption that printing and embossing are, by their nature, identical processes and therefore interchangeable.

This assumption is entirely incorrect. The combination of Montgomery and Leanna is based purely on hindsight reconstruction of the prior art in view of applicants' disclosure. One skilled in the art would not consider combining the references, because the printing of Montgomery and embossing of Leanna are completely different processes by their very nature and completely different equipment is required for the respective processes. Furthermore, Leanna actually teaches away from combining Leanna with Montgomery. Leanna acknowledges that "printing and embossing differ both as regards equipment employed and the nature of the process" (see col. 2, lines 5-8), which further supports applicants arguments.

The Examiner's acknowledgements that Montgomery is **silent** with respect to claimed features of the present invention further supports applicants' argument that there is no reason to arbitrarily take from Leanna the features of a "magnetic cylinder magnetically holding the printing plate firmly during

the setting of an image thereon, the magnetic cylinder having at least one magnet for attracting the printing plate magnetically and being selected from the group consisting of permanent magnets and electromagnets" and "the magnetic cylinder having a register system aligning the printing plate, and the printing plate having substantially U-shaped register cut-outs cooperating with the register system register system" and arbitrarily add them to Montgomery as proposed by the Examiner, but for applicants' disclosure. Therefore, it is submitted that the proposed combination of references is improper. Further, even if the references were combinable, the resulting structure still would not meet the claim limitations.

It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation **in the prior art** to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re

Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be 'clear and particular.'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicants believe that there is no "clear and particular" teaching or suggestion in Montgomery to incorporate the features of Leanna and moreover, that Leanna actually teaches not to incorporate the features in Montgomery because Montgomery and Leanna are non-analogous art.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion,

or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the **applicants'** disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), *cert. den.*, 488 U.S. 825 (1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to modify Montgomery or to add Leanna's features to Montgomery to arrive at the claimed method of using a **printing** plate according to the present invention. Further, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in Montgomery or from knowledge available to those skilled in the art.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps... The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Applicants submit that in

the present instance, no such teaching is present in the cited references.

Clearly, the references do not show "a magnetic cylinder magnetically holding the printing plate firmly during the setting of an image thereon, the magnetic cylinder having at least one magnet for attracting the printing plate magnetically and being selected from the group consisting of permanent magnets and electromagnets, the magnetic cylinder having a register system aligning the printing plate, and the printing plate having substantially U-shaped register cut-outs cooperating with the register system" as recited in claim 5 of the instant application.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 5. Claim 5 is, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1.

In view of the foregoing, reconsideration and allowance of claims 5 and 7-11 are solicited.



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Amdt. dated February 18, 2004  
Reply to Office Action of November 21, 2003

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,

**LAURENCE A. GREENBERG**  
**REG. NO. 29,308**



For Applicants

FDP/bb

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Lerner and Greenberg, P.A.  
Post Office Box 2480  
Hollywood, FL 33022-2480  
Tel: (954) 925-1100  
Fax: (954) 925-1101